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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.              |
|---|-------------|----------------------|---------------------|-------------------------------|
| 10/549,899  | 09/16/2005  | Osama M. Musa        | 3070.EEM            | 7142                          |
| 35157   | 7590        | 08/20/2008           | EXAMINER            |                               |
| NATIONAL STARCH AND CHEMICAL COMPANY<br>P.O. BOX 6500<br>BRIDGEWATER, NJ 08807-3300 |             |                      |                     | BALASUBRAMANIAN, VENKATARAMAN |
| ART UNIT  |             | PAPER NUMBER         |                     |                               |
| 1624  |             |                      |                     |                               |
| NOTIFICATION DATE   |             | DELIVERY MODE        |                     |                               |
| 08/20/2008  |             | ELECTRONIC           |                     |                               |

## Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[patents@nstarch.com](mailto:patents@nstarch.com)

|                              |                                   |                     |  |
|------------------------------|-----------------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>            | <b>Applicant(s)</b> |  |
|                              | 10/549,899                        | MUSA, OSAMA M.      |  |
|                              | <b>Examiner</b>                   | <b>Art Unit</b>     |  |
|                              | /Venkataraman<br>Balasubramanian/ | 1624                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 May 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 5-7 and 9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 6,7 and 9 is/are allowed.  
 6) Claim(s) 5 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Applicants' response, which included cancellation of claims 2, 4 and 8, filed on 5/15/2008, is made of record. Claims 5-7 and 9 are now pending. In view of applicants' response, all prior art rejection made in the previous office action have been rendered moot.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2004 012671 in view of Sakurai et al., JP2003 40939. Sakurai et al., JP 200340939. English Machine Translation provided as Part 1 and Part 2 in the previous office action.

See abstract of JP 2004012671 for a maleimide compound, which is also claimed in instant claim. See compound name- entry CN, which discloses the

trisubstituted compound. The abstract is silent about the process of making. Instant claim 5 requires on maleimide acetic acid ester with trishydroxyethyl isocyanurate.

However, it is known in the art that esters of trishydroxyethylisocyanurate are ease to make. For example, Sakurai et al., teaches the reaction of maleimide-caproic acid with trishydroxyethylisocyanurate to make the trisubstituted compound of claim 2. Sakurai et al., teaches the compound of claim, 2. See entire detailed description(Part 1). See example 8 and formula 12. Note trishydroxyethyl isocyanurate is reacted with maleimide-caproic acid.

Thus, one trained in the art would be motivated to make the disubstituted compound of claim 5 by using two equivalent of maleimide-acetic acid. See *In re KSR International vs. Teleflex Inc.*, 82 USPQ2d 13-85, 1397 (2007).

***Allowable Subject Matter***

Claims 6, 7 and 9 are allowed.

***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624